

REMARKS

Claims 31, 47, 62, 69, and 76 are amended. No claims are added or canceled. In view of the prior cancellation of claims 52 and 80, after entry of this Amendment, claims 31-51, 53-79, and 81-88 will remain pending in this application.

Claims 31-36, 38-51, 53-54, 56-79, and 81-88 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0220978 to Rhodes in view of U.S. Patent Application Publication No. 2003/0149733 to Capiel. Claims 37 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rhodes in view of Capiel and further in view of PCT Patent Application Publication No. WO 01/10090 to Tomkow. The Applicant respectfully disagrees with each of these rejections and, therefore, respectfully traverses the same.

The claims in the present patent application are distinguishable from the references relied upon by the Examiner because they recite, methods and a system where, among other features, identification data is generated from at least a portion of an electronic message and the identification data uniquely identifies the electronic message and distinguishes the electronic message from other electronic messages authorized by an originator. None of the references relied upon by the Examiner describe or suggest at least this feature. As a result, the Applicant respectfully submits that the claims are patentable over the references applied by the Examiner.

Rhodes describes a system and method for message sender validation. As discussed in the reference, the system and method described by Rhodes is based upon the premise that:

Messages from an unrecognized sender are quarantined until the message-designated sender complies with a challenge protocol. Once a sender has complied with the challenge protocol, the sender is included in an inclusion list maintained for the message-designated recipient ID.

(Rhodes at paragraph [0014] (emphases added).) In other words, Rhodes describes a method and system whereby a “white list” is created by the recipient.

As identified in the Specification of the present patent application, the development of white lists is an effective tool for reducing the quantity of unwanted e-mail traffic. (See, e.g., U.S. Patent Application Publication No. 2005/0210106 (hereinafter “the ‘106 Publication”) (the publication of the present application) at paragraphs [0018] – [0019].) However, as also

identified in the Specification, white lists have drawbacks. Specifically, spam e-mail generators are able to bypass both blacklists and whitelists by spoofing an originator's legitimate domain name. (See the '106 Publication at paragraph [0022].) As detailed in the present application, the method and system of the present application undermines an originator's ability to spoof a domain name.

To reduce the volume of unwanted e-mail traffic, Rhodes relies upon a sender verification protocol (or "SVP") that is implemented in one or more message transport pathways, such as SVP 104 in mail server 102 and SVP 114 in the mail client 113. (Rhodes at paragraph [0026].) SVPs 104 and 114 implement processes that interrupt or postpone delivery of e-mail until the message sender passes a user-configurable challenge. (Rhodes at paragraph [0026].) Once the sender has passed the challenge, the sender's identification is added to an inclusion list. (Rhodes at paragraph [0026].) Subsequent messages will bypass the challenge protocol. (Rhodes at paragraph [0026] (emphasis added).) Again, as understood, and as discussed in the reference, Rhodes is directed to the generation of a whitelist, which the present invention improves upon.

Rhodes also describes that senders who are using a sender verification protocol (SVP) in accordance with that invention will include an Originator Key value in the message body. (Rhodes at paragraph [0041].) The Originator Key is a string of a few characters or bytes of sufficient length to uniquely identify the user. (Rhodes at paragraph [0041].) This string may be a word, symbol, or code that is identified with the sender. (Rhodes at paragraph [0041].) The Originator Key is included in all outgoing messages generated by users that are using the invention described by Rhodes. (Rhodes at paragraph [0041].) An Originator Key that is associated with a single user will authenticate that the source of a message is that specific user. (Rhodes at paragraph [0041].) An Originator Key associated with an organization will indicate that the message originated with a member of that organization. (Rhodes at paragraph [0041].)

As described in Rhodes, the Originator Key is included in a challenge e-mail. (Rhodes at paragraph [0042].) The Originator Key prevents a "deadlock" or a "livelock" condition, where both the sender and the recipient use SVP protocols. (Rhodes at paragraph [0042].) In the case where the sender is not trusted, but the message includes an Originator Key, the authenticity of the challenge message is recognized. (Rhodes at paragraph [0050].) As a result, the challenge

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message, which requires input from the sender to pass the challenge (as noted above), is allowed to pass through the protocol, even though the sender is not yet a “trusted” sender. (Rhodes at paragraph [0050].) Importantly, the Originator Key is the same for each message generated by the sender. (Rhodes at paragraph [0041].) The Originator Key is not unique for each message. Nor is the Originator Key generated from any portion of the message.

With this in mind, the Applicant returns the Examiner’s attention to the claims in the present patent application. Each of the claims, by virtue of their dependencies from independent claims, includes the recitation of generating, from at least a portion of an electronic message, identification data that uniquely identifies said electronic message and distinguishes said electronic message from other electronic messages authorized by an originator. As is apparent from the foregoing discussion, Rhodes fails to discuss or suggest any method or system that includes identification data that uniquely identifies said electronic message and distinguishes said electronic message from other electronic messages authorized by an originator. Moreover, Rhodes fails to describe or suggest any method or system where the identification data is generated from at least a portion of the electronic message.

As discussed above, where Rhodes relies upon an Originator Key, the Originator Key does not uniquely identify the electronic message. Instead, the Originator Key uniquely identifies the sender (or the organization to which the sender is affiliated). Next, the Originator Key is the same for every message from the sender, which means that it does not distinguish electronic messages from other electronic messages from the same sender. Finally, the Originator Key has no relation to any part of the message. As a result, the Applicant respectfully submits that Rhodes fails as a reference upon which to base any rejection of the claims for obviousness.

Capiel does not assist the Examiner with a rejection of the claims, because Capiel does not cure the deficiencies noted with respect to Rhodes. As a result, the combination of Rhodes and Capiel cannot render, as obvious, any of the claims in the present patent application.

Capiel describes a method and system for remotely sensing the file formats processed by an e-mail client. (Capiel at the Title and at paragraph [0002].) In an example discussed in the reference, the method and system analyzes the E-mail client by an E-mail sensor server. (Capiel at paragraph [0005].) Once it is known what type of e-mail a recipient can receive (*i.e.*, text

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and/or graphics), it is possible to target content-specific advertisements to those recipients in the appropriate format. (Capiel at paragraph [0005].) The Applicant respectfully points out that Capiel does not address any method or system for reducing unwanted spam.

In the Office Action, the Examiner indicated reliance on Capiel (specifically paragraph [0036]) for the express teaching that data can be provided in an e-mail to “distinguish the electronic message from other electronic messages authorized by the originator.” At paragraph [0036] of Capiel, the reference discusses how a unique identifier is assigned to each E-mail sensor message. (Capiel at paragraph [0036].) This discussion in Capiel is made in connection with the sensor e-mail as outlined at the bottom of page three and at the top of page 4 of Capiel. (Capiel at paragraph [0036] and at pages 3-4.) While there is no discussion of the need for assigning a unique identifying number (*i.e.*, catid=10424522), it seems apparent that the unique identifier for each e-mail from the advertising sender may be needed so that, if the recipient chooses to unsubscribe from the advertisement service (*see, e.g.*, Capiel at page 4, line 3), the advertiser can identify from which advertisement list the recipient is to be removed.

The Applicant notes that the “catid” described by Capiel is a unique number assigned to each e-mail delivered. (Capiel at paragraph [0036].) There is no discussion of how the catid is generated. As a result, there is nothing in Capiel that the Applicant can find to suggest any method or system where there is the generation, from at least a portion of an electronic message, identification data that uniquely identifies said electronic message and distinguishes said electronic message from other electronic messages authorized by an originator. Assigning a unique number to an e-mail bears no relation at least to this element of the claims in the present patent application. As a result, the Applicant respectfully submits that Capiel cannot be combined with Rhodes to render obvious any of the claim in the present patent application.

In view of the foregoing, the Applicant respectfully submits that the Examiner has failed to properly support a *prima facie* case for the obviousness of any of claims 31-36, 38-51, 53-54, 56-79, or 81-88. As a result, the Applicant respectfully requests that the Examiner reconsider the rejection of the claims, withdraw the rejection, and pass this application to issuance.

Concerning the rejection of claims 37 and 55, the Examiner relied on the combination of Rhodes, Capiel, and Tomkow. Tomkow concerns the verification of the delivery and integrity of electronic messages. The Applicant respectfully submits that Tomkow neither addresses nor

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cures the deficiencies noted with respect to Rhodes and Capiel. Since Tomkow does not assist with a rejection of the claims, the Applicant also respectfully submits that the rejection of claims 37 and 55 also should be withdrawn, at least for the reasons identified above.

Each of the rejections having been addressed, the Applicant respectfully requests that the Examiner withdraw the rejection of the claims so that this patent application may pass to issuance.

If there are any fees required for this submission that are not otherwise accounted for, please charge Deposit Account No. 50-2127. In addition, please credit any overpayments to the same Deposit Account.

Respectfully submitted,

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